

Application No. 10/702,440  
Response to Office Action dated February 6, 2006

### Remarks

By the present amendment, claims 1, 8 and 10 have been amended. Claim 7 has been cancelled. Claims 1, 8-10, 13-14, 16-20 are currently pending in the application.

### Rejections Under 35 U.S.C. 103

In Paragraph 3 of the Office action, claims 1, 7-9, 13, 17-18 were rejected under USC 103(a) as being unpatentable over the combination of EP'026, Uytterhoeven and Daubendiek.

A declaration under 37 C.F.R. 1.132 is respectfully submitted herewith. This declaration shows remarkable effects (unexpected effects) arising from the low coated silver amount of the present invention in a photo-thermographic material comprising silver behenate-type organic silver salts and silver halide particles having a high silver iodide content and having a gamma phase. Silver iodide in which a gamma phase is 28 mole % has been known by Daubendiek. But there is no suggestion and no teaching that silver iodide in which a gamma phase is 28 mole % should or could be used in photothermographic materials.

The use of gamma phase silver iodide in a photothermographic material was disclosed by Uytterhoeven and a photothermographic material having a silver halide, an organic silver salt was disclosed in EP'026. But, the silver iodide of Uytterhoeven is mixed with the organic silver salt and also in the examples of the description many kinds of silver iodide were prepared by using a conversion method from organic

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suggestion and teaching of remarkable effects (unexpected effects) such as improvement of the stability to developing time, the color difference to developing time and the color storability arising from the present invention due to decreasing the coated silver amount in a photo-thermographic material comprising silver behenate-type organic silver salts and silver halide particle having a high silver iodide content.

We are convinced that the patentability of the present invention depends on remarkable effects (unexpected effects) arising from the low coated silver amount of the present invention in a photo-thermographic material comprising silver behenate-type organic silver salts and silver halide particle having a high silver iodide content. Therefore, it is respectfully requested that this rejection be withdrawn.

In Paragraphs 5-7 of the Office action, dependent claims 16, 14, 10, 19-20 were rejected under USC 103(a) as being unpatentable over the combination of EP'026, Uytterhoeven and Daubendiek in view of various secondary references. In response, Applicant states that these rejections have been overcome by the present amendment to claim 1, along with the presently submitted declaration and arguments regarding same.

#### **Double patenting rejection**

In Paragraph 9, claim 1, 7-10, 13, 16-20 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim of copending Application No. 10/374,046. There is a significant difference between the copending Application No. 10/374,046 and the present invention. The

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coated silver amount of the above prior application is 0.091 g/m<sup>2</sup> and much higher than the range of the coated amounts of silver in the present invention. And, with regard to the stability of sensitivity to developing time, the color difference to developing time and the color storability, the comparative examples of the prior application are remarkably inferior to the examples of the present invention. We believe the present invention does not fall under obviousness-type double patenting. Therefore, it is respectfully requested that this rejection be withdrawn. A declaration under 37 C.F.R. 1.132 is respectfully submitted herewith to show the difference.

#### **The previous declaration and the scope of the claimed invention**

A declaration under 37 C.F.R. 1.132 is respectfully submitted herewith to show the additional comparative test data which are commensurate with the scope of the claimed invention. And also the amendments to the claims are respectfully submitted. Consequently claim 7 is deleted.

The examiner indicated that the examples of the present invention contain numerous additives and the applicants failed to provide a clear explanation as to why the use of additives in the comparative samples would not affect the properties of the materials as claimed. But, the additives except the additives necessary to the above amended claim 1 does not provide any substantial difference in the effect of the present invention. For example, in the case where development accelerator-1 and -2 are removed, the sensitivity is low compared with the case using these additives, but with regard to the stability to developing time, the color difference to developing time and the color storability, the examples within the range in amounts of silver coating of the present invention are still remarkably superior to the comparative

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examples without the range of the coated silver amount of silver in the present invention. Additional test data in the declaration is respectfully submitted herewith to show the difference.

In view of the foregoing amendments and remarks, it is respectfully submitted that all the claims in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



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